

REMARKS

1. *Status of the Application.* Claims 1-83 are cancelled herein without prejudice or disclaimer to the subject matter thereof. Claims 84-93 are added herein. No new matter is added by the addition of these claims.

In the parent application (United States Patent Application Serial No. 10/027,671, "the '671 Application") to the present Application, the Examiner issued a restriction requirement and identified five groups. Pertinent here, the Examiner stated that for Group IV: "Claims 125-133 [are] drawn to a method of end-derivatizing or introducing an endohedral group to nanotubes, classified in class 423, subclass 460." Office Action, mailed August 29, 2003, in the '671 Application, at 2 ("the '671 Patent Application Office Action"). The present Application is a divisional of the '671 Application and is directed to the claims of Group IV, *i.e.*, Claims 125-133, of the '671 Patent Application.

New Claims 84-90 of the present Application correspond to Claims 125-126 and 129-133, respectively, of the '671 Patent Application (with amendments).¹

As to Claims 91-93 of the present Application, these also correspond to Claims 125-126 and 129, respectively, of the '671 Patent Application (with amendments).² Such amendments include modifying independent Claim 91 of the present Application (from prior independent Claim 125 of the '671 Patent Application) to include the following limitation --wherein the carbon nanotubes comprise at least about 100 carbon atoms--. Support for this limitation is found in the Application, *e.g.*, at p. 35.

All of the Claims 84-93 of the present Application are drawn to a method of end-derivatizing or a method of introducing an endohedral group to nanotubes. Accordingly, consonance is maintained between the subject matter required to be separated by the Examiner in

¹ Applicant notes that new Claim 85 of the present Application is a modification of Claim 126 of the '671 Patent Application. Such modification includes amending the Markush limitation of that new claim to include limitations from Claims 127 and 128 of the '671 Patent Application.

² Applicant also notes that new Claim 92 of the present Application is a modification of Claim 126 of the '671 Patent Application. Such modification includes amending the Markush limitation of that new claim to include limitations from Claims 127 and 128 of the '671 Patent Application.

the '671 Patent Application Office Action restriction requirement and the subject matter claimed in the present Application. *See Texas Instruments, Inc. v. United States Int'l Trade Comm'n*, 988 F.2d 1165, 1179, 26 U.S.P.Q.2d 1018, 1029 (Fed. Cir. 1993).

It is believed that each of the claims now pending in the present Application recites elements neither taught nor suggested by the prior art. Further, it is believed that the present Application as a whole is in proper form and condition for allowance. If the Examiner believes that the present Application may be placed in even better condition for allowance, he or she is invited to contact the undersigned at the telephone number noted below.

Respectfully submitted,

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